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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,082	06/27/2000	Steven M. Bessette	45112-089	4329
23117	7590	07/02/2004	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			AFREMOVA, VERA	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/604,082	BESSETTE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vera Afremova	1651	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4, 19 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 19 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>translation of JP 07145598</u> .       |

### **DETAILED ACTION**

Claims 4, 19 and 45 as amended {4/29/2004} are under examination in the instant office action. Claims 1-3, 5-18, 20-44 and 46-49 are canceled by applicants.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 4 as amended remains rejected under 35 U.S.C. 102(b) as being anticipated by US 4,759,930 in the light of evidence by Fehr et al as explained in the prior office action.

Claim is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition consisting essentially of rosemary oil, peppermint oil and a carrier wherein controlling comprises knocking down and killing the household pests.

US 4,759,930 discloses a method for controlling household pests or cockroaches comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition in a form or plant blends or powders comprising rosemary oil and peppermint oil and a carrier wherein the controlling effect is knocking down and killing the household pests or cockroaches, for example: see col. 1, lines 62-63 and col. 5-6, examples 15-21. The cited patent teaches the use of rosemary and peppermint plant parts or leaves in a form of blends or powders (col. 1, lines 15-45) and it is silent with regard to the oil contents within the rosemary and peppermint plant blends. However, the reference by Fehr et al. demonstrates that

the rosemary and peppermint plant blends contain rosemary oil and peppermint oil. Thus, the plant derived materials or plant derived substance based compositions used in the method of the cited patent are considered to be identical to the composition in the presently claimed method because they inherently comprise rosemary oil and peppermint oil and carriers at least to some extent within the meaning of the claims. Further, the final effect of the cited method is killing pests or cockroaches and, thus, it is identical to the effects/results as required by the claimed invention. Therefore, the cited patent is considered to anticipate the presently claimed invention.

Claim 4 as amended remains rejected under 35 U.S.C. 102(b) as being anticipated by US 4,759,930 in the light of evidence by Fehr et al. and in the light of evidence by Elamrani et al. as explained in the prior office action.

Claim is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition consisting essentially of rosemary oil, eugenol and peppermint oil and a carrier wherein controlling comprises knocking down and killing the household pests.

US 4,759,930 discloses a method for controlling household pests or cockroaches comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition in a form or plant blends or powders comprising rosemary oil and peppermint oil and a carrier wherein the controlling effect is knocking down and killing the household pests or cockroaches, for example: see col. 1, lines 62-63 and col. 5-6, examples 15-21. The cited patent teaches the use of rosemary and peppermint plant parts or leaves in a form of plant blends or powders (col. 1, lines 15-45) and it is silent with regard to the presence of oils

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and eugenol within the rosemary and peppermint plant blends. However, the reference by Fehr et al. demonstrates that the rosemary and peppermint plant blends contain rosemary oil and peppermint oil respectively. The reference by Elamrani et al. demonstrates that eugenol is present in the rosemary oil or in the rosemary plant material. Thus, the plant derived materials or plant derived substance based compositions used in the method of the cited patent are considered to be identical to the composition in the presently claimed method because they inherently comprise rosemary oil and eugenol and peppermint oil and carrier at least to some extent within the meaning of the claims. The final effect of the cited method is killing pests or cockroaches and, thus, it is identical to the effects/results as required by the claimed invention. Therefore, the cited patent is considered to anticipate the presently claimed invention.

Claim 4 as amended remains rejected under 35 U.S.C. 102(b) as being anticipated by JP 07145598 as explained in the prior office action.

Claim is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition consisting essentially of rosemary oil, peppermint oil and a carrier wherein controlling comprises knocking down and killing the household pests.

JP 07145598 discloses a method for controlling household pests comprising step of applying to a desired pest control location a contact pesticidal composition comprising rosemary oil and peppermint oil and a carrier (see English abstract; see official translation page 3/25 at section "purpose" and paragraphs 0020 and 0022). The cited patent teaches the disinfecting effect as the result of applying compositions comprising rosemary oil and peppermint oil. Thus,

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the cited patent is considered to teach controlling pests by killing pets because the disinfecting effect is reasonably expected to provide for pest extermination or killing within the meaning of the claims. Therefore, the cited patent is considered to anticipate the presently claimed invention.

Claim 4 as amended remains rejected under 35 U.S.C. 102(b) as being anticipated by JP 07145598 in the light of evidence by Elamrani et al. as explained in the prior office action.

Claim is directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition consisting essentially of rosemary oil, peppermint oil and eugenol and a carrier wherein controlling comprises knocking down and killing the household pests.

JP 07145598 is relied upon as explained above. Although it is silent with regard to the eugenol presence in the contents of rosemary oil, the eugenol is inherently present in the rosemary oil-containing composition in the method of the cited patent in the light of evidence by Elamrani et al. which demonstrates that eugenol is an inherent component of the rosemary oil. Thus, the cited patent is considered to anticipate the presently claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 19 and 45 as amended remain rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07145598 or US 4,759,930 in the light of evidence by Fehr et al. and in the light of evidence by Elamrani et al. taken with US 6,183,767, US 3,761,584 and Ngoh et al. as explained in the prior office action.

Claims are directed to a method for controlling household pests comprising step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising or consisting essentially of rosemary oil in combination with one or more compounds selected from the group consisting of eugenol, peppermint oil, phenethyl propionate and benzyl alcohol; and a pesticidally acceptable carrier wherein controlling comprises knocking down and killing the household pests.

JP 07145598 is relied upon as explained above for the disclosure of a method for controlling household pests including mites wherein the method comprises step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising carrier, rosemary oil and peppermint oil or a contact pesticidal composition comprising carrier, rosemary oil, eugenol and peppermint oil in the light of evidence by Elamrani et al.

US 4,759,930 is relied upon as explained above in the light of evidence by Fehr et al. and in the light of evidence by Elamrani et al. for the disclosure of a method for controlling or killing household pests wherein the method comprises step of applying to a location where control is desired a pesticidally-effective amount of a contact pesticidal composition comprising carrier and rosemary oil in combination with peppermint oil and at least some amount of eugenol.

The cited patents US 4,759,930 and JP 07145598 are lacking disclosure related to the use of phenethyl propionate and benzyl alcohol in the compositions in the method for controlling or killing the household pests.

The following cited references are relied upon for the missing disclosure.

For example: US 6,183,767 teaches the use of benzyl alcohol and eugenol in the pesticidal compositions that kill household pests (col. 1, line 60, col.3, line 64, col. 4, line 15).

US 3,761,584 teaches that addition of phenethyl propionate into the formulation with eugenol provides synergistic effect for attracting household pests or insects to the location where pest control is desired (abstract).

The reference by Ngoh et al. teaches the killing effect of eugenol and other plant derived benzene derivatives via contact with household pests (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add phenethyl propionate, benzyl alcohol and/or eugenol to the pesticidal compositions comprising rosemary oil and peppermint oil in the method for controlling household pests with a reasonable expectation of success in killing the household pests because these compounds have been known in the art of pesticidal compositions and have been used to control or kill the household pests as adequately demonstrated by the cited references. One of skill in the art would have been motivated to add benzyl alcohol and/or eugenol for the expected benefit of killing household pests. One of skill in the art would have been motivated to add phenethyl propionate to the pesticidal composition for the expected benefit to attract the pests to the location designed for pest control by killing with the pesticidal compositions. It is well known that it is prima facie obvious to combine two or more ingredients



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each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re* Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re* Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re* Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

The claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4, 19 and 45 as amended remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,531,163 in view of US 4,759,930 as explained in the prior office action.

The claims in the present application and the patent US 6,531,163 are each drawn to a method for controlling household pests including cockroaches and ants by applying to the locus

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where control is desired a pesticidally effective amount of a composition with peppermint oil and one or more compound selected from the group consisting of eugenol, phenethyl propionate and benzyl alcohol. The claims of US 6,531,163 are broader, they are open to the use of additional materials and they encompass controlling pests including killing pests. The claimed method of the present application is different from the patented claims in that they require addition of rosemary oil to the composition identical to the compositions in the methods of US 6,531,163. However, it is recognized in the art that the pest controlling effects including pest-killing effects are produced by applying the peppermint oil-containing composition together with the rosemary oil-containing composition as adequately demonstrated by US 4,759,930 (see examples 12, 13 and 15-21).

Accordingly, the claimed methods in the present application and the patent US 6,531,163 are obvious variants. Thus, the inventions as claimed are co-extensive.

### ***Response to Arguments***

Applicant's' arguments filed 4/29/2004 have been fully considered but they are not persuasive.

I. The instant claim 4 is amended by incorporation of language "consisting essentially of". However, when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). The Federal Circuit has stated "By using the term 'consisting essentially of,' the drafter signals that the

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invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.” PPG Industries Inc. v. Guardian Industries Corp., 48 USPQ2d 1351, 1353 (Fed. Cir. 1998). The burden is on the applicant to show that ingredients in a reference which are not listed in a claim are excluded by “consisting essentially of” language meaning that they would effect the basic and novel characteristics of the claimed invention. Until a satisfactory showing is made, the term “consisting essentially of” is considered to be the equivalent of “comprising”. See MPEP 2111.03.

With regard to the claim rejection under 35 USC § 102 applicants’ main argument is directed to the idea that every element of the claimed invention must be present in a single reference (response 4/29/2004, pages 4-7). However, extra reference or evidence can be used to show an inherent characteristic of the thing taught by the primary reference. MPEP 2131.01. In the instant case the cited patent US 4,759,930 (Granier et al.) teaches the use of rosemary and peppermint in the compositions in the method for killing cockroaches. The rosemary and peppermint components as disclosed by the primary reference are present in a form of dry leaves. The dry leaves of rosemary and peppermint inherently contain rosemary and peppermint essential oils in the light of evidence by Fehr. The dry leaves of rosemary inherently contain eugenol in the light of evidence by Elamrani et al.

Thus, the claim rejections under 35 USC § 102 are is proper. “To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that

it would be so recognized by persons of ordinary skill.” Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Note that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1349, 51USPQ2d 1943, 1948 (Fed. Cir. 1999).

With regard to the disclosure by JP 07145598 applicants appear to argue that JP 07145598 is mute about knocking down and killing of household pests (page 8). This is not found persuasive since the cited patent JP 07145598 clearly teaches the purpose of combating molds and mites. The molds and mites are household pests within the meaning of claimed invention.

II. With regard to the claim rejection under 35 USC § 103 applicants’ main argument is directed to the idea that alone or combined the cited reference do not teach suggest or provide motivation to one of skill in the art the features required by the claimed methods (pages 11-12). This is not found persuasive since all presently claimed components are taught by the prior art as effective ingredients in the methods for combating household pests. Therefore, the conclusion is that it is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426

(1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

However, applicants did not present any objective evidence to the contrary as related to combating household pets by using the mixture of components as presently claimed.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

III. With regard to the double patenting rejection claim rejection under 35 USC § 103 applicants argue that claims of US 6,531,163 are devoid of any use of rosemary oil. Yet, the claimed invention is open to incorporation of additional ingredients to the mixture of peppermint oil with eugenol, phenethyl propionate and/or benzyl and the cited patent clearly encompasses the use of additional essential oil. Rosemary derived essential oil is effective in method for combating household plant as adequately taught by the secondary reference. Thus, the claim rejection is proper.

No claims are allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (571) 272-0914. The examiner can normally be reached from Monday to Friday from 9.30 am to 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926.

The fax phone number for the TC 1600 where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Vera Afremova

AU 1651

June 30, 2004



VERA AFREMOVA

PATENT EXAMINER